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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,796	06/11/2001	John M. Krochta	02307O-114420US	3744

20350 7590 03/16/2004

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EXAMINER

PADEN, CAROLYN A

ART UNIT PAPER NUMBER

1761

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/879,796

**Applicant(s)**

KROCHTA ET AL.

**Examiner**

Carolyn A Paden

**Art Unit**

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 12-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-45 and 47 is/are allowed.
- 6) ☒ Claim(s) 1-6, 13-22, 20, 46 is/are rejected.
- 7) ☒ Claim(s) 7-10, 23-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1-22-04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

The request filed on 1-22-04 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/879,796 is acceptable and a CPA has been established. An action on the CPA follows.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 13-22, 29 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krochta et al in view of Trezza and further in view of any of Gilleland (2002/0142031 or 6528088 or 6649188) or McKibben (IFT abstract of March 1, 2001 or IFT Poster Presentation of June 13, 2000) or Wiley Encyclopedia at page 398, lines 1-2.

Krochta discloses a protein-based edible barrier that is made from whey protein isolate or soy protein isolate. At column 4, lines 27-30, the inclusion of a plasticizer is contemplated and the plasticizers are preferably polyalcohols, such as sorbitol, glycerol or polyethylene glycol. The amount of plasticizer is set to be at 1 to 15%. The protein may be used in either a denatured or an undenatured form. The protein in the claims also appears

to be the same protein referred to in the reference. Lipid is also used in the reference at column 6, lines 32-49). Trezza is relied upon to show that edible coatings that contain whey protein isolate are known to have a gloss. Trezza also teaches that whey protein isolate coatings are useful substitutes in chocolate and confectionery applications (see page 658). The claims appear to differ from the reference in the suggestion of a disaccharide or monosaccharide plasticizer. Each of Gilleland, McKibben and Wiley teaches that mono- and di-saccharides are well known plasticizing agents for use in edible films. Gilleland and Wiley also each set forth an array of compounds that can be used as plasticizing agents (page 2, paragraph 0020 and 0021 of 2002/0142031; column 4, lines 13-33 of US 6649188; column 4, lines 26-38 of US 6528088; and page 398, first 2 lines in column 1 of Wiley. Thus these reference draw equivalence among plasticizers that include mono- and di-saccharides as well as the polyols sorbitol and glycerol. Thus it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to substitute mono- or di-saccharide as an equivalent plasticizer in the edible film of Krochta. This obvious substitution is even further demonstrated by the disclosure of the use of lactose as a plasticizer for whey-based films (see

McKibben in the abstract and poster presentation). It is appreciated that confection is not mentioned in the reference, but no unobvious or unexpected result is seen from the selection of the specific food group that is set forth in the claims.

Claims 30-45 and 47 are allowed.

Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.


It is unclear in claim 29 as to how "the combination" and the "or both" are different. An amendment to the claim canceling "or both" would overcome the rejection.

Claims 7-10 and 23-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone number is (571) 272-1403. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (571) 272-1398 or by dialing 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**CAROLYN PADEN** 3-4-04  
**PRIMARY EXAMINER**